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1 RECORD OF ORAL HEARING
2 UNITED STATES PATENT AND TRADEMARK OFFICE

3 _____
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES

6 _____
7 *Ex Parte* AKIHIKO FUJII, YOSHIE YAMASEKI, HIDEO OOMINAMI,
8 RYUJI OCHIAI, and YUSUKE SHIBUYA

9 _____
10 Appeal 2011-001560
11 Application 10/587,258
12 Technology Center 1700

13 _____
14 Oral Hearing Held: November 8, 2011

15 Before BRADLEY R. GARRIS, TERRY J. OWENS, and KAREN M.
16 HASTINGS, *Administrative Patent Judges*.

17 APPEARANCES:
18

19 ON BEHALF OF THE APPELLANT:

20 VINCENT E. SHIER, ESQUIRE
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2 The above-entitled matter came on for hearing on Tuesday,
3 November 8, 2011, commencing at 10:08 a.m., at the U.S. Patent and
4 Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Victor
5 Lindsay, a Notary Public.

6 PROCEEDINGS

7 MR. SHIER: Thank you very much. And again I thank you for the
8 opportunity to discuss this case, as well. With this case, it's related to the
9 last one. And again, what this has to do with is recognition of certain
10 benefits that are obtained by the HHQ and regulation of HHQ, stuff that was
11 never known prior to our invention. And in this case, the features of the
12 claims -- and, again, the brief goes through and establishes that we're
13 arguing these claims independently, or at least in three groups. And those
14 claims are well presented in there, and the arguments today are not a
15 representation of their group, together, in any way.

16 The groupings in the briefings is the groupings that we've maintained
17 still exist for determination of the patentability. However, what we would
18 like to point out is that this case, just like the last one, it's basically the same
19 art, Stelkens and Sosuke is put forward. And in this case, the amount of
20 HHQ that's critical is defined in the claims, either in terms of a weight
21 percent maximum or on the basis of HPLC profiles.

22 In this case, though, what is important is that by decreasing the total
23 content of the HHQ, we give rise to its benefits by eliminating the in vivo
24 production of hydrogen peroxide, known to be involved in the result of
25 several disorders, all of which are recited in our specs -- or some of which
26 are recited in our specification.

1 Prior to this invention, there was no recognition of HHQ's role in the
2 in vivo production of hydrogen peroxide. In fact, prior to this invention, the
3 objective was to decrease the content of H_2O_2 in the coffee itself by using
4 peroxidases and other types of enzymes, even.

5 However, as is stated in the background of the invention -- or, I'm
6 sorry, the summary of the invention, is that what was identified was when
7 you took these coffees, when you depleted the amount of H_2O_2 present, you
8 would still get the in vivo production at very high levels. And so, the
9 Applicants identified HHQ as the agent responsible for accelerating the
10 H_2O_2 production in vivo. And by suppressing the content of HHQ below a
11 certain threshold or its elimination entirely, you would eliminate the
12 production of H_2O_2 , or you would decrease the causative or accelerant effect
13 of coffee. And so, the compositions that are claimed now are coffee
14 compositions, or soluble coffee compositions where we've decreased the
15 total HHQ below certain thresholds.

16 Now, again, the case here is relying upon the generic disclosure of
17 Stelkens, just simply to reduce the content of poisonous substances, which
18 we maintain is insufficient motivation or direction, or even any identity to
19 diminish HHQ. And that, HHQ's level and overall content would not be
20 apparent on the basis of Stelkens. It would not be relevant on the basis -- or
21 it would not be known or apparent on the basis of Stelkens as combined with
22 Sosuke, or any of the other cited secondary references.

23 In this case, clear evidence has been provided to show that if you take
24 the closest examples from the prior art and you compare that teaching

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1 directly to our invention, you cannot achieve the amounts that we have -- the
2 threshold levels as set forth in our claims.

3 In fact, we maintain as well that Stelkens fails to provide adequate
4 motivation to make such further modifications to decrease the content of
5 HHQ. No evidence on record supports any such motivation. And again, this
6 case is very similar to -- process in which the references that are presented
7 before us fail to appreciate the problem, based on the HHQ content, and fail
8 to provide any direction as to how you would change it, and to what level
9 you would decrease HHQ content to achieve the beneficial results that are
10 set forth in our specification. And thus, the results, even if a prima facie
11 case is present, the evidence of record would clearly rebut the prima facie
12 case.

13 JUDGE OWENS: Was the Examiner's statement on page 8 of the
14 Answer, that HHQ is a poisonous substance that has toxic effects on the
15 body such as depleting the DNA strands, wrong?

16 MR. SHIER: My answer to that question is that there is no evidence
17 provided on the record that would support such a statement and that to my
18 personal knowledge, which is divined from the art that is presented in this
19 case, I have no personal knowledge to say that that answer is right or wrong.
20 But I maintain that even if it were a correct statement, there's no suggestion
21 in the art that HHQ has any role or impact and that none of these references
22 are concerned with HHQ, do not disclose HHQ, fail to tell you how you
23 would change the HHQ content to what level and to what effect.

24 JUDGE OWENS: The Examiner's argument on page 4 of the Answer
25 is that you would continue to absorb it onto activated carbon until the
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1 desired level of removal has been achieved to, presumably, prevent the
2 cleavage of DNA strands, which is mentioned on page 8 of the Answer.
3 Why wouldn't that be a good reason to reduce the HHQ content by
4 absorption onto activated carbon until it's zero?

5 MR. SHIER: No reference that is provided provides any basis for
6 that. None of the references of record provide any disclosure as to a role of
7 HHQ.

8 No reference that's of record, as forming a basis of the rejection,
9 provides any appreciation for HHQ, what it is, what it can do, and to
10 motivate one to decrease its content in any way, shape or form, and certainly
11 not to a level as set forth in the claims. Nor does it tell you the beneficial
12 results, especially as to the decreased acceleration of H_2O_2 production in
13 vivo.

14 JUDGE OWENS: Suppose the person of ordinary skill in the art
15 knew that it cleaved DNA strands. Then, would the person have a
16 motivation and reasonable expectation of success in reducing the content of
17 HHQ to zero by absorbing it onto activated carbon for a sufficient time to
18 obtain that degree of removal?

19 MR. SHIER: Well, that hypothetical falls outside the scope of the
20 issues in this case. There's no evidence to establish that there's any factual
21 basis as to what the scope of the knowledge coming into the case is. And
22 even if there were such knowledge, these references, themselves, do not
23 provide any disclosure or support that HHQ itself is being diminished, as in
24 the method practiced by Stelkens, nor is it telling you what that level would
25 have been to. Nor does it provide any further motivation or suggestion that

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1 one would want to further modify it. That level achieved by the Stelkens
2 example wouldn't be sufficient for that objective. So there would be no
3 reason to continue to go forward.

4 There's no identification that that is a result-effective variable and
5 would affect the ultimate outcome in this case. And so, the evidence and the
6 references -- I'm sorry, the references that are set forth in this case do not
7 support a conclusion as to obviousness and the evidence that is provided
8 directly rebutting these particular references are sufficient.

9 JUDGE GARRIS: Any further questions, Judge Owens?
10 Judge Hastings?

11 No, no further questions, sir.

12 MR. SHIER: All right, thank you very much.

13 JUDGE GARRIS: Thank you, Mr. Shier.

14 (Whereupon, the proceedings, at 10:16 a.m., were concluded.)
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